

Foo et al.

S/N: 09/682,685

REMARKS

Claims 1-29 are pending in the present application. In the Office Action mailed July 10, 2003, the Examiner rejected claims 1-29 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of USP 6,498,946. The Examiner also rejected claims 10-14 under 35 U.S.C. §101 as claims directed to non-statutory subject matter. Claims 10 was rejected under 35 U.S.C. §102(b) as being anticipated by Bottemley et al. (USP 5,201,311).

Regarding the Double Patenting Rejection, Applicant submits herewith two Terminal Disclaimers in compliance with 37 CFR §1.321(c). The present application and USP 6,498,946 are commonly owned by General Electric Medical Systems and Mount Sinai Medical Center. Evidence of ownership of the present application may be found at Recs/Frames 012238/0116 as well as 013855/0812.

The Examiner rejected claims 10-14 because the Examiner asserts that "[c]laims to computer programs per se are not statutory subject matter." To support the Examiner's contention, the Examiner cites MPEP §2106, Part IV, B, 1(a) and *In re Beauregard*, 35 USPQ 2d 1383 (Fed. Cir. 1995). However, MPEP §2106, Part IV, B, 1(a) explicitly states that "[w]hen a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim." Claim 10 calls for "[a] computer program having a set of instructions that when executed by a computer cause the computer to: generate and cause application of a non-selective inversion RF pulse...generate and cause application of a slice selective re-inversion RF pulse...apply an inversion time, apply RF excitations, and acquire MR data." As such, claim 10 is clear the "computer is executing the computer program's instructions" and, therefore, claim 10 is clearly statutory subject matter as explained in the very MPEP section cited by the Examiner.

Furthermore, the Examiner's citation of *In re Beauregard* as the substantive case law on point is incorrect. Applicant directs the Examiner to *Diamond v. Diehr*, 450 U.S. 175 (1981) and *State Street Bank and Trust Co. v. The Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998) as controlling case law on point. As explained in MPEP §2106, Part IV, B, 1(a) and the above case law, claims 10-14 clearly call for statutory subject matter under 35 U.S.C. §101.

The Examiner then rejected claim 10 as being anticipated by Bottemley et al. Specifically, the Examiner states that "Bottemley et al. disclose...a method of generating NMR data using a non-selective inversion RF-pulse and slice selective re-inversion pulse" as the sole

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support for the rejection. While the Examiner's statement may or may not be accurate, such is not the claimed invention.

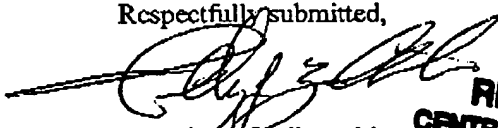
To anticipate a claim, a reference must teach each and every element of the claim. See MPEP §2131. Claim 10, in part, calls for the a non-selective inversion RF pulse to be applied to a slab of slices each having a thickness and a slice-selective re-inversion RF pulse to be applied to a slice thickness greater than the thickness of a single slice. When rejecting claim 10, the Examiner failed to address each and every limitation of the claim. Specifically, the Examiner failed to address the underlined elements of the claim. Nevertheless, Bottomley et al. simply does not teach that a slice-selective re-inversion RF pulse to be applied to a slice thickness greater than the thickness of a single slice. As such, claim 10 is patentably distinct over the art of record.

Therefore, in light of the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-29.

A Fee Transmittal authorizing charging of deposit account no. 07-0845 in the amount of \$220.00 is also enclosed.

Applicant appreciates the Examiner's entry of the Terminal Disclaimers as well as consideration of the remarks set forth herein, and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,


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